

REMARKS

This is a full and timely response to the Restriction Requirement set forth in the Office Action mailed February 1, 2010. Claims 1 and 3 have been amended. New claims 4 – 16 have been added. *These amendments add no new matter.* Support for these amendments may be found variously throughout the Specification, including, but not limited to page 9, line 16 to page 15, line 9 of the Substitute Specification and FIGS. 4 and 5.

Reexamination in light of the following remarks is respectfully requested.

Restriction Requirement

The Restriction Requirement alleges that this application contains three distinct species, specifically:

- **Species I**, said to be drawn to a first data transfer circuit embodiment, characterized by transferring *only an inverted output of a first latch result* from a first latch section to a second latch section,
- **Species II**, said to be drawn to a second data transfer circuit embodiment, characterized by transferring *only a non-inverted output of a first latch result* from a first latch section to a second latch section, and
- **Species III**, said to be drawn to a third data transfer circuit embodiment, characterized by transferring *both an inverted output and a non-inverted output of a first latch result* from a first latch section to a second latch section.

Additionally, the Restriction Requirement alleges that this application further contains three distinct sub-species, specifically:

- **Sub-Species A**, drawn to a first embodiment, wherein the data transfer circuit is applied to a *TFT liquid crystal which comprises a display section and the like formed on a glass substrate.*
- **Sub-Species B**, drawn to a second embodiment, wherein the data transfer circuit is applied to a *Continuous Grain Silicon liquid crystal display apparatus.*
- **Sub-Species C**, drawn to a third embodiment, wherein the data transfer circuit is applied to an *Electro Luminescence display apparatus.*

Election

Applicant provisionally elects, *with traverse*, the invention of the alleged *Species I-A* having claims 1, 3, 4-5, 7-8 and 10-16 readable thereon, if no generic claim is finally held to be allowable.

Traversal

The Office Action asserts that the above species are independent and distinct and requires election of a single species. The Office Action's assertions and requirement of election are apparently based on two grounds.

- The Office Action contends that the allegedly different species listed above do not relate to a single general inventive concept under PCT Rule 13.1 as allegedly demonstrated by the “Y” reference on the International Search Report. (Office Action, p. 6 at No. 6).
- The Office Action contends that the claims to the allegedly different species recite mutually exclusive characteristics and thus cause an examination and search burden for these patentably distinct species. (Office Action, p. 6 at No. 7).

Both of these contentions lack merit.

Concerning the “Y” references, as a preliminary matter, Applicant notes that claim 1 of the original PCT application, the claim considered in the International Search Report, varies significantly from the previously presented claim 1 that the Office Action now restricts. Claim 1 of the original PCT application has been amended since the issuance of the International Search Report. Now, features not recited in claim 1 of the original PCT application are recited in the previously presented claim 1. Because these features were not considered or searched in the International Search, reliance on the International Search Report is no longer germane.

But even if claim 1 of the original PCT application considered in the International Search Report recited all features recited by previously presented claim 1, the Restriction Requirement fails to establish that the special technical feature of the application is known, and thus fails to establish lack of unity of invention.

The Office Action seems to argue that a “Y” reference on an International Search Report is dispositive of a lack of a special technical feature and thus a lack of unity of invention. This argument belies PCT Rule 13 and 40 as expounded in M.P.E.P. § 1850.

Specifically, M.P.E.P. § 1850 teaches:

Whether or not any particular technical feature makes a “contribution” over the prior art, and therefore constitutes a “special technical feature,” should be considered with respect to novelty and inventive step. For example, a document discovered in the international search shows that there is a presumption of lack of novelty or inventive step in a main claim, so that there may be no technical relationship left over the prior art among the claimed inventions involving one or more of the same or corresponding special technical features, leaving two or more dependent claims without a single general inventive concept.

M.P.E.P. § 1850 II. (emphasis added).

So it is not the case that a document discovered in the international search is dispositive that there is no special technical feature left over the prior art. A discovered document in the international search report merely indicates that there may be no technical relationship left over the prior art among the claimed inventions involving one or more of the same or corresponding special technical features.

Whether a discovered document demonstrates that there is no special technical feature requires a further showing. M.P.E.P. § 1850 instructs:

In the case of independent claims to A + X and A + Y, unity of invention is present *a priori* as A is common to both claims. However, if it can be established that A is known, there is lack of unity *a posteriori*, since A (be it a single feature or a group of features) is not a technical feature that defines a contribution over the prior art.

M.P.E.P. § 1850 II. (emphasis added).

Thus, there is lack of unity if it can be established that the claimed technical feature is not a special technical feature that defines a contribution over the prior art.

Yet the Restriction Requirement fails to establish that the special technical features of claim 1 are known. As cited above, M.P.E.P. § 1850 teaches that a document cited in the International Search Report indicates that there may be no technical relationship left over the prior art, but such a document does not necessarily *establish* that the technical feature is known.

Further, M.P.E.P. § 1850 instructs:

There should be a broad, practical consideration of the degree of interdependence of the alternatives presented, in relation to the state of the art as revealed by the international search or, in accordance with PCT Article 33(6), by any additional document considered to be relevant.

M.P.E.P. § 1850 II. (emphasis added).

But despite the instructions from M.P.E.P. § 1850 requiring a “a broad, practical consideration,” Applicant notes that a mere three lines of the Office Action are devoted to a consideration of the degree of independence of the alternatives presented in the application in relation to the state of the art as revealed by the International Search Report. (*See* Office Action, p. 6, ll. 6 – 9).

And more, these three lines fail to address the merits of the “Y” references of the International Search Report but simply note their existence on the Report. In fact, not a single “Y” reference from the International Search Report has been used in rejecting any of the claims of the application. Thus, if these “Y” references are relied upon in the Restriction Requirement, it can hardly be maintained that it has been “established” that the special technical feature is known or that a “broad, practical consideration” has been given or made of record.

Concerning the contention of “examination and search burden,” Applicant notes that this is an application under 35 U.S.C. § 371, based upon international application No. PCT/JP2004/009902.

M.P.E.P. § 1893.03(d) “reminds” Examiners that “unity of invention (not restriction practice pursuant to 37 C.F.R. §§ 1.141 – 1.146) is applicable in international applications ... and in national stage applications submitted under 35 U.S.C. 371.”

Issues of “mutually exclusive species” and “examination and search burden” are raised in restriction practice under 37 C.F.R. §§ 1.141 – 1.146 and described in M.P.E.P. Chapter 800. But 37 C.F.R. § 1.499 and M.P.E.P. § 1850, which are directed to unity of invention, make no mention of “mutually exclusive species” or “examination and search burdens.” Accordingly, it appears that these issues are not relevant when determining unity of invention.

And even if the issues of “mutually exclusive species” or “examination and search burden” were relevant in determining unity of invention, Applicant respectfully disagrees with the contention the listed species create an examination and search burden. The non-elected species have already been searched, examined and acted upon in a prior Office Action.

In sum, because the Restriction Requirement fails to establish that the special technical feature of the application is known, and thus fails to establish lack of unity of invention, and because the Restriction Requirement relies on grounds outside the principles of unity of invention, the Restriction Requirement is improper.

Relief

Withdrawal of this Restriction Requirement and examination of all pending claims is respectfully requested.

An early Action on the merits of this application is additionally respectfully requested.

New Claims 4 – 16

New claims 4 – 16 have been added. *These amendments add no new matter.* Support for these amendments may be found variously throughout the Specification, including, but not limited to page 9, line 16 to page 15, line 9 of the Substitute Specification and FIGS. 4 and 5.

New claim 4 is generic. New claims 5-16 depend from new claim 4. These claims are believed to be in condition for allowance.

Fees

If any fee is required or any overpayment made, the Commissioner is hereby authorized to charge the fee or credit the overpayment to Deposit Account # 18-0013.

Conclusion

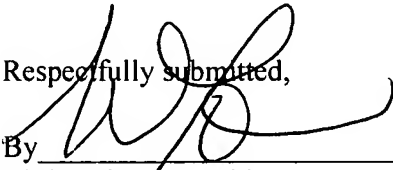
This response is believed to be a complete response to the Office Action. Applicants reserve the right to set forth further arguments supporting the patentability of their claims, including the separate patentability of the dependent claims not explicitly addressed herein, in future papers.

For the foregoing reasons, all the claims now pending in the present application are allowable, and the present application is in condition for allowance.

Accordingly, favorable reexamination and reconsideration of the application in light of the remarks is courteously solicited.

If the Examiner has any comments or suggestions that could place this application in even better form, the Examiner is requested to telephone Chris Tobin, Reg. No. 40,290, at 202-955-8779.

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Respectfully submitted,

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